

Attorney Docket: 030552
U.S. Application 10/673,949 Examiner Ramakrishnaiah
Notice of Appeal and Pre-Appeal Brief Request for Review in Response to September 12, 2007 Final Office Action

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE JAN 11 2008

In re application of: Silver
Application No.: 10/673,949
Filed: September 29, 2003
Title: "SECOND COMMUNICATION DURING RING SUPPRESSION"

Group Art Unit: 2614
Examiner: Ramakrishnaiah

PRE- APPEAL BRIEF REQUEST FOR REVIEW

The Assignee requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Claims 1, 3-5, 7-9, 13, and 15-18 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,714,637 to Kredo in view of U.S. Patent 4,893,329 to O'Brien. Claim 2 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Kredo* in view of *O'Brien* and further in view of U.S. Patent 6,700,957 to Horne. Claim 6 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Kredo* in view of *O'Brien* and further in view of U.S. Patent 6,968,216 to Chen, *et al.*

The pending claims, however, cannot be obviated by the cited documents. As the Assignee has previously argued, any proposed combination involving *Kredo* with *O'Brien* "teaches away" and cannot support a *prima facie* case for obviousness. Moreover, the Assignee previously presented this "teaches away" argument, but the Office failed to consider this rebuttal and failed to provide a response.

The Assignee, then, requests a panel review for the reasons stated below.

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1. Due Process Requires an Adequate Response

The Office has not provided Due Process. The Assignee has previously argued that *Kredo* with *O'Brien* "teaches away." The Assignee has pointed out how *Kredo* with *O'Brien* must have their respective principles of operation changed to support the Office's *prima facie* cases. The Office, however, has failed to respond to this argument. The Office merely responded by reiterating how the pending claims are allegedly obvious. The Office did not respond to, nor does the Office seem to understand, the "teaches away" standard. Due Process, then, requires that the Office consider these "teaches away" arguments and provide a response supported by evidence. Any other action is a violation of the Assignee's Due Process safeguards.

The Panel is thus respectfully requested to remove the final rejection of the pending claims. The Appellant also respectfully requests that the Panel remand the application back to the Examiner for an adequate response to the Appellant's "teaches away" argument.

2. The Office Has Failed to Carry the Burden

The Office has failed to carry its burden of responding to the Appellant's "teaches away" argument. When the Appellant presented a "teaches away" argument, the Office had the burden of rebuttal. The Office, instead, responded with an incorrect obviousness rejection.

The Office has failed its burden. The Appellant has argued that *Kredo* with *O'Brien* "teaches away" and cannot support a *prima facie* case for obviousness. The Appellant, in particular, has presented compelling evidence that either *Kredo* or *O'Brien* must have its principle of operation impermissibly changed to support the *prima facie* case for obviousness. The burden then shifted to the Office for acquiescence or for a factual rebuttal. The Office, instead, responded with silence. The Office has thus failed its burden.

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The Panel is thus respectfully requested to remove the final rejection of the pending claims. The Appellant also respectfully requests that the Panel remand the application back to the Examiner for an adequate response to the Appellant's "teaches away" argument.

3. Because *Kredo* with *O'Brien* "Teaches Away," the § 103 (a) *Prima Facie* Cases for Obviousness Fail

The Office finally rejected the pending claims under § 103 (a) as allegedly being obvious over various combinations of *Kredo*, *O'Brien*, *Horne*, and *Chen*.

Any combination involving *Kredo* with *O'Brien*, however, "teaches away" from the pending claims. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; *see also W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The Examiner's *prima facie* cases all require impermissible changes to either *Kredo*'s or *O'Brien*'s principles of operation. Examiner Ramakrishnaiah proposes to combine *Kredo*'s customized call waiting indicators with *O'Brien*'s device for deferring incoming calls. This proposed combination, however, requires impermissible changes to *Kredo*'s or *O'Brien*'s principles of operation. When *O'Brien* defers an incoming call, *O'Brien* "seizes the telephone line" and the incoming call "will not be completed" to the called party. That is, *O'Brien*'s device for deferring incoming calls would not allow for *Kredo*'s customized call waiting indicators. The proposed combination of *Kredo* with *O'Brien*, then, would never permit "receiving a first incoming communication" and "producing a first initial alert of the first incoming communication," as the independent claims recite. The proposed combination of *Kredo* with

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O'Brien would also never permit “*receiving a second incoming communication during the period of time of suppression*” and “*producing a second initial alert of the second incoming communication*,” as the independent claims recite. As *Kredo's* or *O'Brien's* principle of operation must be impermissibly changed, the *prima facie* cases for obviousness must fail.

Kredo and *O'Brien* explain their principles of operation. *Kredo* discloses customized call waiting indicators, such as custom audio files, tones, and text that are associated to calling phone numbers. See U.S. Patent 6,714,637 to *Kredo* at column 2, lines 35-45. See also *id.* at column 2, lines 60-65 and at column 4, lines 1-10. *O'Brien* describes a device that defers incoming telephone calls so as not to disturb the called party. See U.S. Patent 4,893,329 to *O'Brien* at column 1, lines 6-13. “**In the defer mode of operation, the device detects a valid ring signal, suppresses the telephone ringers, seizes the telephone line and transmits to the calling party a ... voice message.**” *Id.* at column 2, lines 6-10 (emphasis added). “**While the subscriber line is in the defer mode, calls placed to it will not be completed but will instead be intercepted at the central office.**” *Id.* at column 10, lines 41-43 (emphasis added). “**The calling party will be given a voice message ... that the called party is not accepting calls.**” *Id.* at column 10, lines 44-46 (emphasis added). Local and long distance calls are not completed when in the defer mode of operation. See *id.* at column 10, lines 55-58.

Kredo with *O'Brien*, then, “teaches away” from the pending claims. If *Kredo* is combined with *O'Brien*, as the Office proposes, then *Kredo's* entire teaching (e.g., customized call waiting indicators) must be eliminated, or, *O'Brien's* principle of operation must be changed to not play a voice message and to, instead, allow incomings calls to be completed. Because the patent laws forbid changing a principle of operation to support a *prima facie* case, the proposed combination of *Kredo* with *O'Brien* cannot support a *prima facie* case for obviousness. All the *prima facie* cases for obviousness must fail, so the Office is respectfully requested to remove the § 103 (a) rejections of the pending claims.